



# UNITED STATES PATENT AND TRADEMARK OFFICE

*Clm*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,671	09/23/2003	Hiroshi Takei	242831US0	9100
22850	7590	02/28/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ZIMMER, MARC S	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 02/28/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 10/667,671	<b>Applicant(s)</b> TAKEI ET AL.	
	<b>Examiner</b> Marc S. Zimmer	<b>Art Unit</b> 1796	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because:

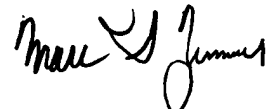
In a December 27, 2007 interview, Applicant had attempted to convince the Examiner that the rejection was improper because there had been, to that point, no attempts to support the Examiner's contention that the particular adhesion promoters disclosed in their claims were well known and obvious with evidence provided by the prior art. (The Examiner had provided a fairly lengthy analysis of the role of adhesion promoters, their general mode of action and, hence, the functional groups that would be required of them in preparing a composite article of the type summarized in Okami.) Applicant was advised that they could indeed compel the Examiner to provide evidence of their obviousness but the Examiner emphasized that no previous challenge had been mounted that may have obliged him to furnish this kind of evidentiary support. Instead, Applicants had attempted to show non-obviousness simply by comparing the level of adhesivity existing between the silicone layer and the intermediate layer in the absence of an adhesion promoter versus the result obtained when an adhesion promoter had been added to the silicone film-forming composition. The Examiner made the determination that it was not unexpected that the adhesivity would be significantly better were an adhesion promoter to be added to a film-former that had been devoid of this component. As an aside, the Examiner is confident that the obviousness of the particular adhesion promoters disclosed in Applicant's claims could be illustrated with some facility.

Recalling Applicant's other observation that the intermediate layer of the corresponding prior art invention was porous, the Examiner had advised Applicant that, should they identify support for requiring the intermediate layer to be non-porous, i.e. by illustrating that one or more of the thermoplastic films mentioned in their Examples were non-porous, the rejection could possibly be overcome in this fashion. Applicant has responded by furnishing a Rule 1.132 affidavit stipulating that the amendment is supported by Applicant's earlier disclosure of an exemplary article having an intermediate layer comprising TEONEX.

It shall first be noted that the product data sheet that accompanies Applicant's statements is actually silent as to the porosity of a TEONEX film. It is also to be emphasized that the term "porous" has numerous meanings and Applicant does not appear to have anywhere in the original Specification defined this term thereby making it difficult to ascertain the scope of an intermediate layer that is "non-porous". For instance, one definition of "porous" is "full of tiny pores that allow fluids or gasses to pass through". In this connection, the Examiner observes that TEONEX is a polyethylene naphthalate film. A quick survey of the prior art verifies that polyethylene naphthalate is permeable to at least some gases including oxygen thus the issue of whether TEONEX is a porous film depends on one's definition of porous.

It is on the basis that the film is not described in terms of a pore size that Applicant purports it to be non-porous. This, quite frankly, seems to be a tenuous position. Further, had Applicant actually regarded this as an important aspect of their invention, the term "porous" almost certainly would have been defined in a meaningful way.

The Examiner appreciates that he pointed Applicant in the direction of claiming their invention in terms of the porosity of the intermediate layer but the allowability on these grounds was contingent upon the Applicant having demonstrated unequivocally that the materials used in their Examples were non-porous. Unfortunately, they have not yet met this burden.



MARC S. ZIMMER  
PRIMARY EXAMINER